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EXAMINER	
TUCKER, WESLEY J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATSUSHI TESHIMA

Appeal 2009-008804
Application 09/872,008
Technology Center 2600

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge,* CARL W. WHITEHEAD, JR., and BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. §§ 6(b) and 134(a) from the Examiner's final rejection of claims 3-6, 8, and 10-19.

We affirm-in-part.

Appellant's invention relates to an image registration computer system wherein image data is uploaded from first client devices (e.g., computers) to an image server. The image server stores the uploaded image data on an image database, and second client devices (e.g., portable terminals) can later access the image database via the server to download the image data. The second client devices may require that image data be processed into a different form (e.g., reduced in size for smaller display screens) prior to downloading, though, and the processing required to change the image data's form can be a relatively time-consuming. The point of the invention, then, is for the server to process the image data it received from the first clients, convert the received image data into a different form of representation, and then store the processed form of the image data on the image database. The different form of the image data that is stored on the image database is suitable for image output to the second client devices. Accordingly, the time required for downloading the image data to the second client devices is reduced relative to if the image data were stored in the database in the original form received from the first client devices. (*See, e.g.,* App. Br. 3-6; Figs, 1, 2, 5-9).

Claims 3, 8, and 10-19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Lee (US 6,658,167 B1; Dec. 2, 2003).

Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as obvious over Lee.

Appellant argues that Lee does not anticipate any of the claims because:

(1) each of independent claims 3, 8, 10, and 11 requires:

(a) image data generating means that processes the image data received from the first client device in order to generate image data in a different form of representation, and

(b) image data storage means that stores the processed image data of the different form of representation; whereas,

(2) Lee does not store image data that has been converted to a different form of representation.

(App. Br. 12-40).

The Examiner finds that the claims do not require that the image data be previously generated and stored (Ans. 13), and

> [Lee teaches that] when image data is optimized or modified . . . [the data is inherently] previously generated and stored in the sense that they [sic: it] must be generated and stored or reside somewhere in memory before or even during transferring. Lee teaches that the image data is modified at the server and then transmitted only after being generated in optimized form . . . . [Where Lee discloses] that operations are performed on the fly or each time a request is made, the image data must inherently be stored in a memory in order for the enhanced, optimized or modified image to exist in digital from [sic: form] at all. If the modified digital image is not stored, then where in cyberspace does it reside? Storage of the modified image is inherent to the existence of modified image data to be sent over a network connection.

(Ans. 13-14; citations omitted).

ISSUES

1. Regarding independent claims 3, 8, and 11, did the Examiner err in finding that Lee discloses "image data storage means for storing the [generated] image data"?

2. Regarding independent claim 10, did the Examiner err in finding that Lee discloses the step of "storing the generated image data"?

3. Regarding dependent claims 18 and 19, did the Examiner err in finding that Lee discloses that the modified image data can be generated and stored prior to the server receiving request data?

ANALYSIS

Claims 3-6, 8, and 11-17

All three independent claims, claims 3, 8, and 11, set forth an image transmission server that comprises "image data storage means for storing the [generated] image data." This language presumably constitutes means plus function language per 35 U.S.C. § 112, ¶ 6, and the Examiner has not alleged otherwise (Ans. 3-18). As such, the claim limitation must be construed to cover "the corresponding structure, material, or acts described in the specification and equivalents thereof." (*In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc)). However, the Examiner's Answer does not indicate that the Examiner has performed any analysis of what structures in Appellant's Specification correspond to the claimed "image data storage means" much less any analysis of what structures are the

equivalents thereof. As such, the Examiner has not established a prima facie showing that Lee discloses the claimed "image data storage means."

Accordingly, we do not sustain the Examiner's anticipation rejection of independent claims 3, 8, and 11, or of claims 12-17 which depend from claims 3 and 11.

With respect to the obviousness rejection of dependent claims 4-6 over Lee, the Examiner's additional reliance upon Official Notice does not cure the deficiency of the anticipation rejection explained above. Accordingly, we do not sustain the obviousness rejection of these claims either.

Claim 10

Independent method claim 10 does not invoke "step plus function" language, but instead, more broadly reads as follows:

> 10. In an image transmission server which can communicate with a client device, an image transmitting method, comprising:
>
> generating image data representing an image which can be outputted to the client device and representing the same image as an image represented by fed image data and including a different form of representation;
>
> storing the generated image data so as to be accessible from the client device;
>
> receiving request data representing a request to transmit the stored image data;
>
> finding the image data suitable for image output to the client device which has transmitted the request data out of the stored image data in response to the receiving request data; and

transmitting to the client device the found image data.

We do not see how this claim language distinguishes over Lee. The Examiner has found that all processed data – even data that has been modified on the fly or after each time a request is made – must necessarily be stored somewhere, at least temporarily (e.g., in an output buffer), in order to be sent over a network connection (Ans. 13-14). Appellant has not provided any evidence that such data storage is not necessarily required or explained why this position is erroneous (*see* App. Br. 12-41).

Accordingly, we sustain the anticipation rejection of independent method claim 10.

Claims 18 and 19

Claims 18 and 19 both depend directly from claim 10. These dependent claims are narrower than independent claim 10 in that claims 18 and 19 both require that the modified image data be generated and stored prior to the server receiving request data. The Examiner, though, states that the claims are rejected for the same reasons as were set forth in relation to independent claim 3 (Ans. 18). Accordingly, we do not sustain the anticipation rejection of claims 18 and 19 for the same reasons as set forth in relation to claims 3-6, 8, and 11-17 *supra*.

CONCLUSIONS

(1) The Examiner has established that claim 10 is unpatentable under 35 U.S.C. § 102(b).

(2) The Examiner has not established that claims 3-6, 8, and 11-19 are unpatentable under 35 U.S.C. §§ 102(b) and 103(a).

DECISION

We affirm the Examiner's rejection of claim 10.

We reverse the Examiner's rejections of claims 3-6, 8, and 11-19.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v). *See* 37 C.F.R. § 1.136(a)(1)(v) (2010).

AFFIRMED-IN-PART

gvw

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